



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,976	11/26/1999	SATORU MAEDA	7217/60194	6965

7590 04/23/2004

JAY H MAIOLI
COOPER & DUNNER LLP
1185 AAVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

BELIVEAU, SCOTT E

ART UNIT	PAPER NUMBER
----------	--------------

2614

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/449,976

Applicant(s)

MAEDA ET AL.

Examiner

Scott Beliveau

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 2614

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-3 been considered but are moot in view of the new ground(s) of rejection.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “superimposing means superimposes for superimposing only the name of the sender and the subject of the electronic mail message at a predetermined position on the television picture displayed on said display means so that the television picture is not obscured” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

Art Unit: 2614

relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the specification fails to describe that the “superimposing means superimposes . . . at a predetermined position on the television picture displayed on said display means so that the television picture is not obscured”. Rather, the specification discloses that the superimposing means overlaps the television picture (IA: Page 5, Lines 1-4; Page 6, Lines 10-22). It is unclear as to how the embodiment may superimpose the television picture with a visual indication of a new message in a manner that does not obscure at least a portion of the original television picture. As illustrated in applicant’s Figure 3, the lower left hand portion of the television picture displaying the notification of the electronic mail message is obscured. Even if the particular portion of the television picture at the moment of the superposition was empty/blank, the embodiment would still be obscuring that empty/blank portion of the television picture. Assuming that the notification were opaque (not disclosed in the specification), it would still partially obscure at least the predetermined position/portion of the television picture.

Furthermore, the specification fails to describe the “superimposing means for superimposing only the name of the sender and the subject of the electronic mail message”. The examiner finds no particular reference within the specification so as to narrow the superimposing information to “only” that of the sender and the subject. As illustrated in Figure 3, it would appear that a border is further superimposed in addition to the name of the sender and subject.

For the purpose of art evaluation, the examiner shall presume that the claims have been amended so as to support an interpretation that the limitation of “only the name of the sender

Art Unit: 2614

and the subject of the electronic mail message” will not preclude the addition of additional graphical objects so as to highlight or distinguish the particular notification. Furthermore, the limitation restricting the display of the notification such that the “television picture is not obscured” shall be interpreted such the scope/meaning of the “not obscuring” limitation is limited such that the viewer of the television picture can determine the name of the sender and the subject matter of the e-mail, while still watching the television picture being displayed as represented in Figure 3.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belamy et al. (US Pat No. 6,209,025) in view of Foladare et al (US Pat No. 5,905,777).

In consideration of claim 1, the Bellamy et al. reference generally discloses a “television receiver” that facilitates the integration of Internet services and telephony services comprising a “connection interface for connecting to an external mail server” [13/14], an “electronic mail means” (Col 7, Lines 26-35), a “display means for displaying a television picture”, a “central processing unit” [20] (Col 3, Line 64 – Col 5, Line 15), and a “display memory” (Col 4, Lines 33-37 and 50-51). The reference subsequently discloses that the PC [10] is operable to “download a plurality of electronic mail from the mail server” and to subsequently utilize “superimposing means for superimposing” [5] an alert as to the receipt of the new message on “a television picture for display on said display” (Col 7, Lines 27-35). Such an alert may be displayed “at a predetermined position on said display means so that the television picture is not obscured” such that the information may be displayed in the form of a semi-permanent portion of the TV screen (Col 7, Lines 42-46). The particular display of the information on a portion of the TV screen is interpreted such that the display of such information in a designated portion would still be operable to be alerted to the delivery of an electronic mail message while still watching the television picture being displayed (Col 3, Lines 29-33)

While the reference does not explicitly disclose that the PC [10] comprises “random access memory”, the usage of such is well known to those having ordinary skill in the art. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize “random access memory” in conjunction with the PC [10] for the purpose of providing a storage medium for the “downloaded email message”.

The Bellamy reference, however, does not disclose nor preclude the composition of the alert such that it does not comprise “only the name of the sender and the subject of each of the electronic mail”. The Foladare et al. reference suggests an alert method wherein “only the name of the sender and the subject of each of the electronic mail” are utilized (Col 2, Lines 51-67). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to display the “only the name of the sender and the subject of each of the electronic mail messages” as an alert as taught by Foladare et al. in conjunction with the Bellamy embodiment for the purposes of providing a means by which users may be alerted in a time efficient manner such that they may quickly ascertain based on the sender and subject if a message is of importance (Foladare et al.: Col 1, Lines 31-40).

With respect to the particular display of the notification, the combined references do not explicitly disclose, nor preclude that “only the name of the sender and the title are horizontally scrolled for each successive electronic mail on said display means”. The Bellamy discloses that it is operable to display the alert information form of a real-time information banner (Col 7, Lines 42-46). The examiner takes OFFICIAL NOTICE that it is notoriously well known in the art to use real-time information banners to successively display information in a horizontally scrolled manner. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize an information banner as disclosed by Bellamy that further “horizontally scrolls” for the purpose of presenting the user with a continuous stream of real-time information including a electronic mail alerts in a manner that presents information to the user while minimizing screen real estate and does not interrupt a program with successive pop-up windows.

Art Unit: 2614

Claims 2-3 are rejected wherein the aforementioned “central processing unit” [20] is operable to “control accepting an electronic mail check command” so as to “retrieve each new successive electronic mail” message and “to display the name of the sender and the title of the electronic mail along with the television picture on said display means” (Col 6, Lines 1-12). Such messages are implicitly displayed “in sequence” such that the messages are displayed in a scrolling fashion when they are retrieved based upon the receipt of a message.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Wagner et al. (US Pat No. 6,282,435) reference discloses a user interface that indicates the receipt of electronic mail messages via a “horizontally scrolled” ticker (Figure 3A; Col 6, Lines 26-50).
- The Knudson et al. (US Pat No. 6,536,041) reference discloses a program guide system that utilizes real-time data sources in the form of a customizable ticker.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

Art Unit: 2614

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB
April 19, 2004


JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600